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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,873	12/30/2004	Walter Stieglbauer	STIEGLBAUER ET AL - I PCT	7849
25889	7590	05/03/2007	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			KERN, KEVIN P	
			ART UNIT	PAPER NUMBER
			1725	
			MAIL DATE	DELIVERY MODE
			05/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/519,873	Applicant(s) STIEGLBAUER ET AL.	
	Examiner Kevin P. Kerns	Art Unit 1725	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent-term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/9/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4 and 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the electrode protection strip". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Okita et al. (US 5,552,573).

Okita et al. disclose a resistance welding process and apparatus for welding of aluminum and aluminum alloy workpieces (e.g. metal sheets), in which the apparatus includes an insert material 9 provided over the electrode 1 and between the electrode 1 and the workpieces (11,12) as holding means for the insert material 9 (strip), such that

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the insert material 9 has a sheet-like core material 9a made of iron, steel, copper, or copper alloy (having melting temperatures above 1000°C), and congruently arranged coated strip layers (9b,9c) made of Ni, Ni alloy, Ti, Ti alloy, Nb, Nb alloy, Mo, Mo alloy, W, W alloy, Cr, Cr alloy, Co, and Co alloy (having melting temperatures above 1000°C) that face the electrode 1 and workpieces (11,12), such that the superimposed strips (9a,9b,9c) would be exclusively positively connected via metallic (diffusion) bonding (e.g. plating, clad welding etc.) between the two metals, while the strips are able to be displaceably held via holding means at different speeds relative to each other via reels (22,23,24,25) – (i.e. means for driving and holding the strip -- see Figure 5; and column 10, lines 43-51), with little or no adhesion of the strips to the electrode and workpieces during resistance welding (abstract; column 3, lines 24-58; column 4, lines 32-48; column 7, lines 1-26; 1<sup>st</sup> paragraphs of Examples 1-13; and Figures 1, 2, 5, and 6).

### ***Response to Arguments***

5. The examiner acknowledges the applicants' amendment provided with an Information Disclosure Statement (IDS) received by the USPTO on April 9, 2007. The IDS has been considered and initialed, and a copy is provided with this Office Action. The applicants' amendments overcome prior objections to the abstract and specification, as well as all except one of the 35 USC 112, 2<sup>nd</sup> paragraph rejections (see above section 2). The 35 USC 102(b) rejections in view of the Goodwin reference are overcome by the applicants' amendment, as Goodwin does not teach the means for driving the strip set forth in amended independent claim 1. The applicants have

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cancelled claim 6 and non-elected claims 10-22. Claims 1-4 and 7-9 are currently under consideration in the application.

6. Applicants' arguments filed April 9, 2007 have been fully considered but they are not persuasive.

With regard to the applicants' remarks/arguments on pages 7 and 8 of the amendment, the applicants are referred to the newly underlined portions of the 35 USC 102(b) rejections which show additions of claimed features (as taken in view of the amended claims) in above section 4. Since the Goodwin reference is no longer applied, the remarks/arguments on page 7 of the remarks are rendered moot. With regard to the remarks on page 8, the applicants' major argument is that the metal strips of Okita et al. are not "exclusively positively connected" (see 2<sup>nd</sup> paragraph on page 8). The examiner respectfully disagrees with this statement, as Okita et al. disclose a sheet-like core material 9a made of iron, steel, copper, or copper alloy (having melting temperatures above 1000°C), and congruently arranged coated strip layers (9b,9c) made of Ni, Ni alloy, Ti, Ti alloy, Nb, Nb alloy, Mo, Mo alloy, W, W alloy, Cr, Cr alloy, Co, and Co alloy (having melting temperatures above 1000°C) that face the electrode 1 and workpieces (11,12), such that the superimposed strips (9a,9b,9c) would be exclusively positively connected via metallic (diffusion) bonding (e.g. plating, clad welding etc.) between the two metals (see above section 4). In addition, the holding means and driving means (provided in the applicants' amendments) are also disclosed in above section 4 in the newly underlined portions.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kevin P. Kerns whose telephone number is (571) 272-1178. The examiner can normally be reached on Monday-Friday from 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kevin P. Kerns *Kevin Kerns 5/1/07*  
Primary Examiner  
Art Unit 1725

KPK  
kpk  
May 1, 2007